



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/153,994	09/17/1998	NANCEY J. HAMMOND	660082.527M	6324

27076 7590 08/15/2003

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
SUITE 3400
1420 FIFTH AVENUE
SEATTLE, WA 98101

EXAMINER

BULLOCK JR, LEWIS ALEXANDER

ART UNIT	PAPER NUMBER
----------	--------------

2126

DATE MAILED: 08/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/153,994

Applicant(s)

HAMMOND, NANCEY J. 

Examiner

Lewis A. Bullock, Jr.

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Affidavit or Declaration

1. The declaration/affidavit filed on 9/16/02 under 37 CFR 1.131 has been considered but is ineffective to overcome the Miyamoto and Shinomura references.
2. The evidence submitted is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the Miyamoto and Shinomura references. The evidence demonstrates conception of the invention prior to the effective date. However, as disclosed in 37 CFR 1.131 there is no evidence of due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application (See also MPEP 715.03, Formal Requirements for Affidavits and Declarations / Three Ways to Show Prior Invention). Applicant states in the response that the invention was diligently reduced to practice, however, the examiner has no evidence of this assertion.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-3, 6-12, 15-23, and 25-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over MIYAMOTO (US 5,793,973) in view of "Messaging's next blockbuster hit" by COX.

As to claim 1, MIYAMOTO teaches a method in a computer system for a sender (transmitting device) of an electronic message (electronic mail) to ensure that the message is delivered and reviewed by intended users (receiving device) comprising: sending an electronic message; requesting from the recipient a notification (reply); determining a waiting period (user mentally what should the retransmission time interval be) for receiving the notification (notification); selecting a delivery time interval (via setting the retransmission time interval setting box based on the number of days corresponding to the waiting period; and without user intervention, when the notification (reply) from the recipient user (receiving device) is not received by the sender within the selected time interval (retransmission interval), resending the electronic message to the recipient user (col. 8, line 59 – col. 11, line 50; especially col. 8, lines 59-62). However, MIYAMOTO does not explicitly teach the composing of the electronic message, indicating and selecting a plurality of intended recipient users, and that the notifications are delivery and review notifications. It would be obvious and well known to one of ordinary skill in the art at the time of the invention that in order to send an electronic message one has to compose the message, and indicate a plurality of intended users by selecting delivery recipients (to addresses) and review recipients (cc addresses).

COX teaches that sending mail systems request a read receipt or notification, a delivery receipt or notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious to one skilled in the art that based on the combination the request for a response is a request for a read receipt or a delivery receipt to be received prior to the retransmission interval expiring. Therefore, it

Art Unit: 2126

would be obvious to one skilled in the art at the time of the invention to combine the teachings of MIYAMOTO with the teachings of COX in order to determine whether the recipient has actually opened the message or has merely received it (pg. 6).

As to claim 15, MIYAMOTO teaches a method in a computer system for delivery of an electronic message (electronic mail), the method comprising: determining whether after sending of the electronic message to a recipient (receiving device) a pre-determined period of time (retransmission time interval) has elapsed without receiving a confirmation (reply) of the electronic message from the recipient, the predetermined time period corresponding to a time interval selected by a sender (via retransmission time interval setting box); and when it is determined that the pre-determined period of time has elapsed without receiving the confirmation, sending another electronic message (col. 8, line 59 – col. 11, line 50; especially col. 8, lines 59-62) However, MIYAMOTO does not explicitly state that confirmation message is a review confirmation message.

COX teaches sending mail systems can request a read receipt or notification, i.e. review receipt, a delivery receipt or notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious to one skilled in the art that based on the combination the request for a response is a request for a read receipt or a delivery receipt to be received prior to the retransmission interval expiring. Refer to claim 1 for the motivation to combine.

As to claim 6, refer to claim 15 for rejection. However, claim 6 details the confirmation is delivery of the message instead of reviewing of the message and of resending the electronic message instead of sending another electronic message. COX teaches that a sending mail system requests delivery notification in addition to read notification (pg. 6, fifth paragraph). MIYAMOTA teaches when a reply to an electronic mail is not received to automatically retransmit the e-mail (col. 8, lines 59-62).

As to claim 28, MIYAMOTO teaches a method for a sender (transmitting device) of an electronic message to ensure that the electronic message is reviewed by a recipient (receiving device), the computer-implemented method comprising: determining whether after sending of the electronic message to a recipient a specified amount of time has elapsed without receiving an confirmation from the recipient (col. 3, lines 6-28), when it is determined that the period of time has elapsed without receiving the indication, automatically requesting a confirmation from the sender to resend the electronic message (prompting setting means); and when the confirmation is received from the sender, resending the electronic message (col. 3, lines 6-28; col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; especially col. 8, lines 59-62). However, MIYAMOTO does not teach the indication is a review confirmation.

COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious to one skilled in the art that based on the combination the request for a response is a request for a read receipt or a delivery

receipt to be received prior to the retransmission interval expiring. Refer to claim 1 for the motivation to combine.

As to claim 36, MIYAMOTO teaches a computer system for ensuring that an electronic message is reviewed by a recipient, comprising: a message sender (transmitting device); a message tracker (register); and a message processor (CPU) (col. 3, lines 6-28; col. 9, lines 3-16; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47; especially col. 8, lines 59-62). However, MIYAMOTO does not teach the indication is a review confirmation.

COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious to one skilled in the art that based on the combination the request for a response is a request for a read receipt or a delivery receipt to be received prior to the retransmission interval expiring. Refer to claim 1 for the motivation to combine.

As to claim 2, MIYAMOTA teaches the resending is performed for a recipient (receiving device) not returning a notification (reply) within the waiting period (retransmission interval) (col. 8, line 59 – col. 11, line 50; especially col. 8, lines 59-62). It is well known in the art at the time of the invention that an e-mail is capable of sending to multiple recipients for delivery and review and therefore obvious that the resending is for each recipient that does not return a reply.

As to claim 3, It is well known in the art at the time of the invention, that the priority of a message is capable of being transmitted and elevated and that the user designates such elevation.

As to claim 16, COX teaches requesting the confirmation (pg. 6, fifth paragraph).

As to claims 17 and 18, COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be inherent that in order to detect that a message is reviewed (read), one has to monitor the electronic message.

As to claim 19, refer to claim 2 for rejection.

As to claim 20, MIYAMOTO teaches the period of time is based on past performance of the recipient (col. 12, lines 15-32; col. 11, lines 18-26).

As to claim 21, refer to claim 3 for rejection.

As to claim 22, MIYAMOTO teaches another electronic message is a reminder message (prompting mail) sent to the recipient distinct from the sent electronic message

Art Unit: 2126

(col. 3, lines 6-28; col. 9, lines 3-16; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47).

As to claim 23, refer to claim 3 for rejection.

As to claim 25-27, It would be obvious that since the message is retransmitted until a reply is received, i.e. every 3 days (col. 8, lines 59-62; col. 9, lines 3-16), that if a confirmation is not received in the second pre-determined time interval, i.e. 4-6 days, a third message is sent, i.e. after the 6th day.

As to claim 29, MIYAMOTO teaches the electronic message is sent to a plurality of recipients and receiving a specification (prompting setting means) of the amount of time for each recipient such that automatic requesting of the confirmation (sending a prompting message) is performed when no indication is received within the specified amount of time (col. 3, lines 6-28; col. 9, lines 3-16; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47).

As to claim 30, MIYAMOTO teaches graphically presenting to the sender a request to send the electronic message (col. 5, line 57 – col. 7, line 52; col. 8, line 63 – col. 9, line 2).

Art Unit: 2126

As to claim 31, MIYAMOTO teaches when it is determined that the period of time has elapsed without receiving the indication, automatically requesting a confirmation from the sender to send a third electronic message within a second amount of time (col. 3, lines 6-28; col. 8, line 63 – col. 9, line 16; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8).

As to claims 32 and 33, reference is made to a computer readable medium which corresponds to the method of claims 15 and 19 and is therefore met by the rejection of claims 15 and 19 above.

As to claim 34, reference is made to a computer readable medium that corresponds to the method of claim 22 and is therefore met by the rejection of claim 22 above.

As to claim 35, refer to claim 25 for rejection.

As to claim 37, MIYAMOTO teaches the message sender is further for receiving indications (replies) and for receiving a specification (via prompting setting means) of the amount of time for each recipient wherein the message tracker determines whether the sent message was reviewed within the specified amount of time and the message process for sending the second message for each recipient that did not review the sent message within the specified time (sending a prompting message) (col. 3, lines 6-28;

Art Unit: 2126

col. 9, lines 3-16 ; col. 10, lines 25-37; col. 10, line 62 – col. 12, line 8; col. 13, lines 8-47).

As to claim 38, It would be obvious that since the message is retransmitted when no reply is sent within the specified amount of time that as long as there is no reply and before the deadline to the message, it will be subsequently resent multiple times.

As to claim 7, refer to claim 19 for rejection.

As to claim 8, refer to claim 20 for rejection.

As to claim 9, refer to claim 21 for rejection.

As to claim 10 and 11, COX teaches requesting confirmation of the delivery to the recipient (pg. 6, fifth paragraph). It would be obvious that the recipient is queried in order to determine if the message is delivered.

As to claim 12, COX teaches sending mail systems can request a read receipt, a delivery notification, or both be sent back to confirm that a user has received a mail message (pg. 6, fifth paragraph). It would be obvious that if a confirmation message is requested by a client computer in response to any message sent to the server, that in response to a server requested read receipt, a server computer can send a delivery

Art Unit: 2126

receipt to the client computer notifying the client computer of receipt of its sent read receipt.

5. Claims 4, 5, 14, and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over MIYAMOTO in view of COX as applied to claim 15 above, and further in view of SHINOMURA (US 6,108,709).

As to claim 4 and 5, MIYAMOTO and COX substantially disclose the invention. However, neither reference explicitly teaches the cited limitation. SHINOMURA teaches determining a user able to prompt review of the electronic message by the recipient user; and sending an electronic message to the determined user when no notification is received from the recipient within the waiting period (condition) (col. 15, lines 21-30 ; col. 16, lines 33-37; col. 16, line 58 – col. 17, line 13). Therefore, it would be obvious to combine the teachings of MIYAMOTO with the teachings of COX and SHINOMURA in order to provide a superior data sending apparatus with an alternate forwarding function (col. 2, lines 35-52).

As to claim 24, MIYAMOTO and COX substantially disclose the invention. However, neither reference explicitly teaches the cited limitation. SHINOMURA teaches the electronic message is sent to a second recipient distinct from the recipient, and the another message prompts the second recipient to facilitate review by the recipient of the sent electronic message (col. 15, lines 21-30; col. 16, lines 33-37; col. 16, line 58 – col. 17, line 13). Refer to claim 4 for the motivation to combine.

As to claim 14, refer to claim 24 for rejection.

Response to Arguments

6. Applicant's arguments filed 5/29/03 have been fully considered but they are not persuasive. Applicant argues that Miyamoto that the prompting e-mail message in the event a requested response is not obtained is not the initial transmission. The examiner disagrees. Miyamoto explicitly states at column 8, lines 59-62, that when an electronic mail which needs a reply to be sent is transmitted but no reply has been received, the same electronic mail is retransmitted automatically. Therefore, Miyamoto does teach that the prompting e-mail message is the initial transmission.

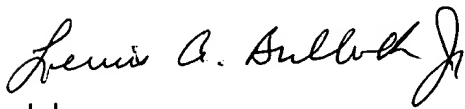
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis A. Bullock, Jr. whose telephone number is (703) 305-0439. The examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A Follansbee can be reached on (703) 305-8498. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Art Unit: 2126

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-0286.

A handwritten signature in cursive script, reading "Lewis A. Bullock Jr.".

lab
August 11, 2003